

### REMARKS

#### Amendments to the Claims

Claim 1 has been amended in response to the rejection under 35 U.S.C. § 112, first paragraph. The amended claim 1 retains all previous limitation, with the additional recitation that movement of one of the flag arms causes the detector to send a signal. This additional recitation was previously presented in claim 9 and is neither new matter nor newly presented claimed subject matter.

Amended claim 1 is similar to claim 9, with claim 9 reciting the additional limitation of a second shaft that is adjacent to the roller. Because of this difference in claim scope, claim 3 is being cancelled to prevent the occurrence of duplicate claims.

It is requested that this After Final amendment be entered into the record as it will significantly reduce any issues for appeal and does not require further searching as the best prior art will have already been searched for and considered for claim 9.

#### 35 U.S.C. §112, second paragraph

Claims 1-7 and 9-13 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

It is being held that the specification fails to describe an embodiment in which the roller switch has a pair of flag arms such that each flag arm generates a signal. Claim 1 has been amended, wherein it is recited that one of the flag arms of the pair of identical flag arms causes the photoelectric detector to send a signal – such is disclosed in the original application.

Additionally, it is held that the specification does not disclose that there is a pair of “identical” flag arms. Applicants’ disagree with this holding. Figures 1 and 3 show two flag arms 26 that are identical in structure, though only one flag arm interacts with a signal detector. The specification refers to both flag arms by a single reference numeral 26, indicating to those skilled in the art that the two flag arms are similar, or identical in construction. While the specification does not use the exact word “identical,” this is not fatal to the application, as recognized by the court: “[t]he failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.” All Dental Products LLC v. Advantage Dental Products, 64 USPQ2d 1945, 1948 (Fed. Cir. 2002).

Given the figures and the singular reference numeral for both flag arms, and the various elements of the flag arms, one skilled in the art would recognize that the word "identical" reflects what the specification shows was invented by Applicants at the time of filing. It is requested that this rejection be withdrawn.

Applicants object to the inclusion of claims 9-12 in this 112 rejection. Independent claim 9 recites that "one of the pair of flag arms causes the photoelectric detector to send a signal." The original specification discloses that one of the flag arms causes the detector to send a signal. Also, claim 9 does not contain the objected to word "identical."

### 35 U.S.C. § 103

Claims 1-7 and 9-13 have been rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's Admitted Prior Art (AAPA). This rejection is respectfully traversed for the following reasons.

AAPA as shown in Figure 4 is being used as 103 rejection. As the AAPA is a switch that sits on only one side of the conveyor belt, there is no second flag arm. However, the Office Action states "it would have been obvious to one of ordinary skill in the art to provide the second identical flag arm in the device of AAPA, since such a modification would have involved a mere duplication of a component. It should be noted that mere duplication of a known component is generally recognized as being within the level of ordinary skill in the art."

The rejection appears to rely upon MPEP 2144 wherein it states that it is permissible to rely upon court holdings for a rationale to support an obviousness rejection. The case cited by MPEP 2144.04 for duplication of parts is *In re Harza*, 124 USPQ 378 (CCPA 1960). However, the courts have held that "reliance on *per se* rules of obviousness is legally incorrect and must cease," *In re Ochiai*, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995).

While not binding precedential opinion, the Board of Patent Appeals and Interferences, *ex parte Granneman*, Appeal No 2002-1760, Application No. 09/355,509, in considering the blanket use of *In re Harza*, stated that to establish a *prima facie* case of obviousness, the teachings from the prior art must appear to have suggested the claimed subject matter and the mere fact that the prior art could be modified as suggested by the legal holding of *In re Harza* is not sufficient to establish a *prima facie* case of obviousness (Board referenced *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The *ex parte* Granneman Board noted that the examiner failed to explain how the prior art would have fairly suggested

to one of ordinary skill in the art to duplicate a feature of the prior art to achieve the recited invention and reversed the outstanding rejections. Similar to *ex parte* Granneman, no reasoning or explanation for how the AAPA would suggest to one to duplicate any feature of the roller switch is provided in the present rejection.

A *prima facie* case of obviousness under the *Graham v. Deere* standard is established when there 1) must be some suggestion or motivation in the art to modify or combine the references; 2) must be a reasonable expectation of success and 3) the combined references must teach or suggest all the claim limitations. The AAPA fails to suggest providing more than one flag arm, fails to suggest having a roller mounted on a shaft that extends between the pair of flag arms, fails to suggest a shaft extending between the flag arms (as recited in claim 9), or having only one flag arm cause a signal if a pair of arms is present. Absent the reliance on the *in re Hazra* to provide motivation to change the AAPA, there is no motivation to modify the AAPA.

MPEP 2144 permits the examiner to only use prior legal decisions "if the facts in a prior legal decision are sufficiently similar to those in an application under examination. If the applicant has demonstrated the criticality of a specific limitation, it would be inappropriate to rely solely on case law as the rationale to support an obviousness rejection."

The facts of present application and *In re Hazra* are not similar. Hazra sought to claim an additional rib in a water seal web wherein the prior art showed only a singular rib (see the illustration provided in MPEP 2144.04), this is a duplication of a minor element of the web. Herein, any duplication of a flag arm is not a duplication of a minor element, AAPA has only a single flag arm attached to a roller that extends only a partial distance across the conveyor. To modify the AAPA in the manner suggested would require more than just a duplication of the flag arm, but to correspond to claim 1 would also require an extension of the roller, and to correspond to claim 9 would also require a second shaft to extend between the flag arms. Because the scale of asserted duplication in AAPA is vastly different than for Hazra, the facts are sufficiently similar to permit the Examiner to use the legal holding of *in re Hazra*.

Additionally, in the specification, Applicants have noted the criticality of duplicate flag arms and the roller extending between the pair of flag arms (spec, pg 2). The AAPA is subject to being knocked out of adjustment. The pair of flag arms, mounted on opposing ends of the roller reduces miss-adjustments, provides greater robustness and durability of the roller switch. Thus, based on MPEP, it is inappropriate to rely solely on a judicial holding to

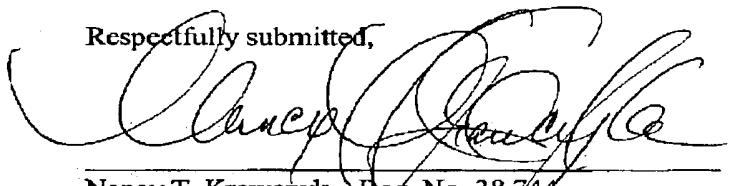
support the present obviousness rejection.

All of the dependent claims have been blanket rejected with the independent claims, however, the AAPA, whether or not modified as suggested in the Office Action, fails to suggest that the photoelectric detector is unblocked due to vertical movement of the roller (claim 4), that the entire roller switch is capable of pivoting about one end (claim 5), that the flag arm is capable of being fixedly raised (claim 6), that the switch has a pair of end plates with one end plate having pivoting means and the other end plate having a locking tube (claim 7), and that the switch has a support beam upon which the detector is mounted (claim 11).

It is respectfully requested that this rejection be reconsidered and withdrawn.

In light of this amendment, all of the claims now pending in the subject patent application are allowable. Thus, the Examiner is respectfully requested to allow all pending claims.

Respectfully submitted,

  
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